

**REMARKS**

***Status of the Claims***

Claims 1-18 are pending in the application and claims 1, 5, 13, 17, and 18 are amended herein. Applicant asserts that no new matter is presented by the amendments to the claims and respectfully requests entry of same.

***Claim Objections should be withdrawn.***

Claim 5 stands objected to because the word "second" located in line 4 should be changed to "first." Claim 5 has been amended to correct this error.

***Rejections under 35 U.S.C. § 103 should be withdrawn.***

Claims 1-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Aldershof (U.S. Patent No. 3,145,481) in view of Donovan (U.S. Patent No. 3,620,553). Applicant respectfully disagrees for at least the following reasons.

With regard to Claim 1, the Examiner cites the case *In re Gulack* for the proposition that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability.

This invention sets forth in Claim 1: "A system for selective collection of information comprising: a first complete information collection sheet, including a first portion for collection of a first information and a second portion for collection of a second information, said first portion including a first select information section; a second complete information collection sheet underlying said first complete information collection sheet in overlapping position, ..., said second complete information collection sheet including a third portion for collection of a third

information and a fourth portion for collection of a fourth information, said third portion including a second select information section.” The first and third portions are to be distinguished from the second and fourth portions, the first and third portions also respectively including first and second select information sections. In some embodiments of this invention, the first and second select information sections are for collection of non-confidential information while the second and fourth portions are reserved for confidential information.

Claim 1, as amended, further sets forth: “a reproduction enabling media underlying said first and second complete information collection sheets, said reproduction enabling media in direct communication with said first and second select information sections and not in direct communication with said second or fourth portions.” In order for the reproduction enabling media to be “in direct communication with said first and second select information sections and not in direct communication with said second or fourth portions,” the second or fourth portions must be at the bottom of their complete information collection sheets. Consequently, the second and fourth portions are not, while the first and second select information sections are, in direct communication with the reproduction enabling media. In this manner, only the non-confidential information in the first and second select information sections is transferred to the record data sheet. But for this arrangement, the confidential information is not transferred to the record data sheet while the non-confidential information is. Thus, Applicant asserts that there is a functional relationship between the claimed printed matter and the substrate and that it is both novel and unobvious.

Notwithstanding, in an effort to further prosecution of this application and clarify what Applicant regards as his invention, Claims 1, 13, 17 and 18 are amended herein. Support for these amendments can be found in the original specification at least in paragraph 24. Applicant

notes for the record that these amendments are not an admission that the invention as previously claimed was obvious, but are rather being submitted to expedite prosecution of this application.

In addition to being patentable for the reason's set forth above, the amended claims are patentable because Donovan teaches away from combination with Aldershof (MPEP §2145) and the prior art fails to teach or suggest each and every claim limitation (MPEP §2143.03).

Claim 1 as currently amended reads: "A system for selective collection of information comprising: a first complete information collection sheet, including a first portion for collection of a first information and a second portion for collection of a second information, said first portion including a first select information section; a second complete information collection sheet underlying said first complete information collection sheet in overlapping position, wherein a top edge of said second complete information collection sheet is substantially aligned with a bottom edge of said first select information collection section of said first complete information collection sheet, said second complete information collection sheet including a third portion for collection of a third information and a fourth portion for collection of a fourth information, said third portion including a second select information section; a reproduction enabling media underlying said first and second complete information collection sheets, said reproduction enabling media in direct communication with said first and second select information section and not in direct communication with said second or fourth portions; and a record data sheet underlying said enabling media, said record data sheet in communication with said reproduction enabling media."

It is improper to combine references when the references teach away from the invention as claimed. (MPEP §2145) Donovan teaches duplication of *all* of the written-in information (Column 4, Lines 47-49) (Column 5, Lines 38-42) whereas claim 1 recites that "said

reproduction enabling media...not in communication with said second or fourth portions” Emphasis added. In fact, duplication of anything less than *all* of the written-in information in Donovan would render the invention useless as the entire point of Donovan is to copy all the information on a check. Copying only some of the information of the check is pointless in light of Donovan’s teachings. Because Donovan teaches away, the references may not be properly combined per MPEP §2145.

Further, the invention as claimed in claim 1 is not obvious because all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03

Neither reference teaches “a reproduction enabling media in direct communication with first and second select information sections and not in direct communication with second or fourth portions” Because this element is not taught or suggested by Aldershof or Donovan taken independently or together, the Examiner has not established *prima facie* obviousness of the claimed invention.

In view of the foregoing remarks, Applicant respectfully requests withdrawal of the rejection as to Claim 1 as well as to Claims 2-12 pending in this application as being dependent upon Claim 1 and incorporating all the limitations thereof.

Claim 13 as currently amended reads: “A system for selective collection of information comprising: a plurality of complete information collection sheets stacked in overlapping manner, wherein each one of said plurality of complete information sheets includes a first portion for collection of select information and a second portion for collection of nonselective information; a reproduction enabling media underlying said plurality of complete information collection sheets, said reproduction enabling media in contact with said first portion of each one of said plurality of complete information collection sheets and not in contact with said second portion of each one of

said plurality of complete information collection sheets; and a record data sheet underlying said reproduction enabling media, said plurality of complete information collection sheets positioned such that a top edge of each underlying one of said plurality of complete information collection sheets is substantially aligned with the bottom edge of the first portion of the next preceding overlying one of said plurality of complete information collection sheets, said plurality of complete collection sheets, reproduction enabling media and record data sheets being immovably positioned one to the other.”

As explained above, because Donovan teaches away from the claimed invention because it teaches the copying all the information whereas claim 13 recites “said reproduction enabling media in contact with said first portion of each one of said plurality of complete information sheets and not in contact with said second portion” Further, the referenced prior art does not teach the claimed element of a reproduction enabling media in contact with said first portion of each one of said plurality of complete information collection sheets and not in contact with said second portion of each one of said plurality of complete information collection sheets. Because this element is not taught or suggested by Aldershof or Donovan taken independently or together, the Examiner has not established *prima facie* obviousness of the claimed invention.

In view of the foregoing remarks, Applicant respectfully requests withdrawal of the rejection as to Claim 13 as well as Claims 14-16 pending in this application as being dependent upon Claim 13 and incorporating all the limitations thereof.

Claim 17, as currently amended reads: “A method for select collection of information, comprising: using one of a plurality of complete information sheets to provide information, the plurality of complete information collection sheets being arranged in overlapping manner such that topmost sheet is obscuring a first portion of the next successive underlying sheet the

plurality of sheets further arranged such that only a portion of each sheet is in contact with a reproduction enabling media for reproducing the information provided to the portion of each sheet in contact with the media; reproducing on a record data sheet in real-time information provided to the portion of each plurality of complete information collection sheets; and removing a topmost one of the plurality of complete collection sheets to provide information to the next successive underlying sheet.”

Again, Donovan teaches away from the invention as claimed because Donovan teaches the reproduction of all the information whereas claim 17 includes the element of “the plurality of sheets further arranged such that only a portion of each sheet is in contact with a reproduction enabling media” Further, the referenced prior art does not teach the claimed element of a plurality of sheets further arranged such that only a portion of each sheet is in contact with a reproduction enabling media for reproducing the information provided to the portion of each sheet in contact with the media. Because this element is not taught or suggested by Aldershof or Donovan taken independently or together, the Examiner has not established *prima facie* obviousness of the claimed invention. As such, Applicant respectfully requests withdrawal of the rejection as to Claim 17.

Claim 18, as currently amended reads: “A method for select collection of information, comprising: arranging a plurality of sheets in an overlapping manner such that the topmost sheet is obscuring a first portion of the next successive underlying sheet of the plurality of sheets; arranging the plurality of sheets such that only a portion of each sheet is in contact with a reproduction enabling media for reproducing the information provided to the portion of each sheet in contact with the media; and enabling the reproduction in real-time on a record data sheet information provided to the portion of each plurality of complete information collection sheets.”

Once again, because Donovan teaches away from the claimed element of “arranging the plurality of sheets such that only a portion of each sheet is in contact with a reproduction enabling media,” the references may not be properly combined. Further, the referenced prior art does not teach the claimed element of arranging a plurality of sheets such that only a portion of each sheet is in contact with a reproduction enabling media for reproducing the information provided to the portion of each sheet in contact with the media. Because this element is not taught or suggested by Aldershof or Donovan taken independently or together, the Examiner has not established *prima facie* obviousness of the claimed invention. As such, Applicant respectfully requests withdrawal of the rejection as to Claim 18.

**CONCLUSION**

In view of the foregoing remarks, Applicant believes that the present application and pending claims 1-18 are in condition for allowance. If the Examiner has question or suggestions on how to place the claims in better condition for allowance, he is invited to telephone the undersigned at the Examiner's convenience. Finally, Applicant authorizes and respectfully request that any fees due (including extension fees) be charged to Deposit Account No. 19-2814.

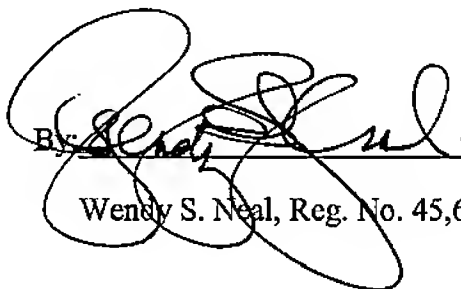
**This statement does NOT authorize the payment of the issue fee.**

Respectfully submitted,

Date:

24 January 2007

By:



\_\_\_\_\_

Wendy S. Neal, Reg. No. 45,615

**SNELL & WILMER L.L.P.**

400 East Van Buren

Phoenix, AZ 85004-2202

Phone: (602) 382-6334

Fax: (602) 382-6070